

REMARKS

Claims 1-10 are pending. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Di Meco et al. (US2002/0015825) in view of Osako et al. (EP 1,052,425) and claim 6 further in view of Di Meco et al. (EP 1,157,813).

Reconsideration is requested. Claims 1, 3 and 6 are amended; claims 5 and 7 are canceled and new claims 11-13 are added.

Claim 3 is amended to depend from claim 2 and a copy of the prior claim 3 is added as new claim 11.

Claim 1 is amended by adding the following features:

"said fabric (5) being treated with a liquid solution of RFL impregnating the fibres of the fabric and successively coated on the outside with a resistant layer (8)" (support at page 1 last line) and "wherein said fluorinated plastomer is in an amount by weight of between 101 and 150 parts by weight with respect to said elastomeric material" (from original claim 5, now canceled).

Method claim 8 is similarly amended.

These further limiting features should distinguish present claims 1 and 8 both from Osako and from Di Meco.

New claim 13 is added to protect a resistant layer adhered to the teeth of a toothed belt (1), said resistant layer (8) comprising a fluorinated plastomer and an elastomeric material wherein said fluorinated plastomer is formed for more than 50% by particles of average size smaller than 10 μm .

The examiner rejected the claims on the basis that Osako would show how to use PTFE particles of average size lower than 10 μm regardless of the exact teachings disclosed in Osako, which, according to the Applicant's opinion, are limited to a liquid treatment and cannot be extended to a solid layer.

In responding to the Applicant arguments, the Examiner argues that Osako et al reference is not relied on for the existence of the layer or the position of the layer and is relied on only for the particle size of a fluorinated plastomer. Di Meco et al teaches the resistant layer. Further he states that "optimal strength weight and wear characteristics should be provided to the belt; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the resistant layer taught by Di Meco et al. and Osako reference is only taken into consideration for the dimension of the particles".

According to this point of view, one can always combine two documents to find the claimed solution independently from or regardless of the teachings of the documents. It is improper under 35 U.S.C. § 103(a) because it ignores the actual teachings of the prior art, which is not what a person skilled in the art would do, and which is contrary to the requirement to consider the teachings as a whole of a reference.

Further, the Examiner seems to suggest that the combination would involve only a "routine experimentation" thus negating the possibility both of combination invention and selection invention. Further, to say: "...it is not inventive to discover the optimum or workable ranges by routine experimentation" is contrary to the last sentence of 35 U.S.C. § 103(a) (as amended since 1955) which states: "Patentability shall not be negated by the manner in which the invention was made." Moreover, the Examiner ignores the precondition of the quoted phrase: "Where the general conditions of the claim are disclosed in the prior art..." See In re Aller, 220 F.2d 454, 456, 105 USPQ 233,235 (CCPA 1955). Such general conditions are not met in this case.

Also, a particular parameter must be recognized as a result-effective variable before a determination of optimum range might be characterized as routine experimentation. See In re

Antonie 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The Examiner has not even attempted this kind of showing.

Present claim 1 is distinguished by adding that the fabric is firstly treated with a liquid treatment and secondly is coated with a resistant layer in that order. Thus, the belt of the present invention is not only subjected to both treatments but the two treatments are totally different; hence no combination of materials is apparent between the two treatments.

Further amendments to claim 1 limit the claim to a very specific ratio between the fluorinated plastomer and the elastomer which is not suggested by Osako.

Accordingly, claim 1 is allowable.

Claim 8, similarly amended, is likewise allowable.

New claim 13 is directed to a resistant layer adhered to a toothed belt. The only disclosure in Osako of a layer refers to the rubber cement (or latex) of the RFL (which we remind is the acronym for Resorcin Formhaldeyde Latex) which is a liquid treatment as it appears clearly from Table 3 of Osako.

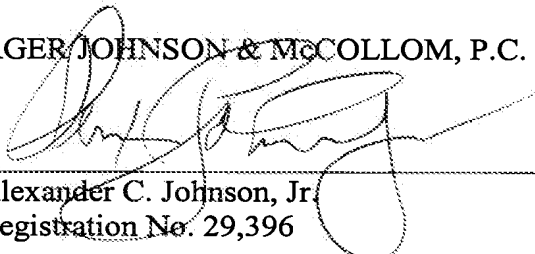
In review of the foregoing amendments and remarks, the application should be in condition for allowance. If any questions remain, the Examiner is requested to call the undersigned.

Respectfully submitted,

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